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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,803	11/28/2000	Gregory G. Cappiello	34013-28PT	7805

7590 06/24/2002
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EXAMINER

SPYROU, CASSANDRA

ART UNIT PAPER NUMBER

2872

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,803

Applicant(s)

CAPPIELLO ET AL.

Examiner

Jon W. Henry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-145 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the invention of Group I, species (1)(b), and species (2) (w) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that on various grounds, none of which are found persuasive for the following reasons.

Applicants' remarks assert that restriction between combination and subcombination is only proper if the combination does not require the particulars of the subcombination for patentability. Applicant's confusion is understandable in that an error in the USPTO form paragraph used in item no. 2 of the last Office action that indicates that MPEP 806.05(c) Section III requires that the combination does not require the particulars of the subcombination for patentability. In fact, in evidence claim situations, as indicated in that paragraph, and as noted in applicants' remarks, page 2, lines 15-18, the standard in evidence claim situations is that an evidence claim is present that indicates the combination *is not relying on* the particulars of the subcombination, even though the claimed combination does clearly *require* the particulars of the subcombination. See MPEP 806.05(c) Section III. The examiner regrets the error in not properly modifying the USPTO form paragraph to clearly indicate the criteria of evidence claim restriction practice. Additionally, applicants' remarks, pages 2 and 4, rely on the fact that various claims include the Bbr features of claim 65. That merely helps explain why various inventions are grouped together in Group II, not why Groups I and II should not be divided for examination purposes.

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Applicants' remarks in the paragraph bridging pages 4 and 5 misconstrue the standard of the subcombination having utility by itself or in other combinations. The subcombination clearly would have separate utility as a decorative display device. The fact applicants' have not disclosed such a use is irrelevant to that conclusion or division partly based on that conclusion. Additionally, where such a device would be classified is irrelevant to division of inventions. A possible unclaimed use of a subcombination rarely, if ever, controls classification.

The requirement is still deemed proper. However, based on the further restriction requirement that follows, applicants' election is not made FINAL as set forth below.

2. Based on a further review of this application, a preliminary search, and consideration of the large number of claims to the elected invention in this application, the examiner has determined that a further restriction requirement is necessary to reduce the serious burden of searching and examining the independent and distinct inventions in this application.

The inventions are distinct, each from the other because of the following reasons:

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

III. Claims 2-34, drawn to a diffraction grating designed with various specifics not those of invention IV, classified in class 359, subclass 566.

IV. Claims 35-39 and 46-50, drawn to a diffraction grating with grating specifics, classified in class 359, subclass 569.

2. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility from the invention of

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invention IV because invention IV relates to only one of several independent and distinct species that also include the features of invention III. See MPEP § 806.05(d) and the last Office action.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. A telephone call was not made to applicants' representative to request an oral election to the above restriction requirement because applicants' are given the opportunity to reconsider the election made in the last Office action based on the further restriction of the elected invention set forth above.

5. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Claim 1 is considered to link(s) inventions III and IV based on the grating profile being designed to diffract over a wavelength range of at least about 30 nm being considered to be an inherent features of diffraction gratings with the claimed grating specifics of claims 35 and 46 of invention IV. If applicants' do not agree that is true, they should clarify such in their response. Applicants' acquiescence in that conclusion will be taken as agreement by applicants in the further prosecution of this application. If the features of claim 1 are not inherent in the claimed invention of Group IV, claim 1 is not a linking claim but is directly only to invention III and should be included in that group and not examined with Group IV. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked

inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to McMahon, He et al, and Fu et al disclose polarization insensitive diffraction gratings in various multiplexing and demultiplexing environments.

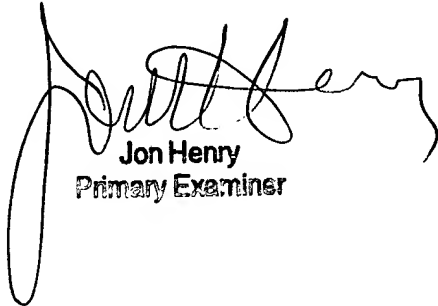
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

jwh
May 17, 2002



Jon Henry
Primary Examiner